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10/580,134

05/30/2007

Mark D. Erion

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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

SHIAO, REI TSANG

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

04/09/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

1. Claims 1-2, 83, 100, 117, 139-140, 227-235, and 239-241 are pending in the application.

Election/Restriction

2. Restriction is required under 35 U.S.C. 121 and 372.

Lack of Unity Requirement

3. This application contains the following inventions or groups of inventions, which are not so linked as to form a single inventive concept under PCT Rule 13.1.
 - I. Claims 1-2, 83, 100 and 239-241, in part, drawn to compounds/compositions of formula (I), and methods of use. If this group is elected, applicants are requested to elect a single species for the search purpose.
 - II. Claims 117 and 239-241, in part, drawn to compounds/compositions of formula (II), and methods of use. If this group is elected, applicants are requested to elect a single species for the search purpose.
 - III. Claims 139-140 and 239-241, in part, drawn to compounds/compositions of formula (III), and methods of use. If this group is elected, applicants are requested to elect a single species for the search purpose.

- IV. Claim 227, drawn to compounds of formula (X). If this group is elected, applicants are requested to elect a single species for the search purpose.
- V. Claim 228, drawn to methods of use using compounds of formula (Y). If this group is elected, applicants are requested to elect a single species for the search purpose.
- VI. Claim 229, drawn to methods of use using compounds of formula (Y). If this group is elected, applicants are requested to elect a single species for the search purpose.
- VII. Claim 230, drawn to methods of use using compounds of formula (Y). If this group is elected, applicants are requested to elect a single species for the search purpose.
- VIII. Claim 231, drawn to methods of use using compounds of formula (Y). If this group is elected, applicants are requested to elect a single species for the search purpose.
- IX. Claims 232, drawn to compounds of formula (VIII). If this group is elected, applicants are requested to elect a single species for the search purpose.

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- X. Claim 233, drawn to methods of use. If this group is elected, applicants are requested to elect a single species for the search purpose.
- XI. Claim 234, drawn to methods of use. If this group is elected, applicants are requested to elect a single species for the search purpose.
- XII. Claim 235, drawn to methods of use. If this group is elected, applicants are requested to elect a single species for the search purpose.

Upon thorough consideration of the claims, the examiner has determined that a lack of unity of invention exists, as defined in Rule 13.

PCT Rule 13.1 states that the international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention").

PCT Rule 13.2 states that unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features.

Annex B, Part 1(a), indicates that the application should relate to only one invention, or if there is more than one invention, inclusion is permitted if they are so linked to form a single general inventive concept.

Annex B, Part 1(b), indicates that "special technical features" means those technical features which as a whole define a contribution over the prior art.

Annex B, Part 1(c), further defines independent and dependent claims. Unity of invention only is concerned in relation to independent claims. Dependent claims are defined as a claim which contains all the features of another claim and is in the same category as the other claim. The category of a claim refers to the classification of claims according to subject matter, e.g. product, process, use, apparatus, means, etc.

Annex B, Part 1(f) indicates the "Markush practice" of alternatives in a single claim. Part 1(f(i)) indicates the technical interrelationship and the same or corresponding special technical feature is considered to be met when: (A) all alternatives have a common property or activity, and (B) a common structure is present or all alternatives belong to a recognized class of chemical compounds. Further defining (B) in Annex B, Part 1(f)(i-iii), the common structure must; a) occupy a large portion of their structure, or b) the common structure constitutes a structurally distinctive portion, or c) where the structures are equivalent and therefore a recognized class of chemical compounds, each member could be substituted for one another with the same intended result. That is, with a common or equivalent structure, there is an expectation from knowledge in the art that all members will behave in the same way. Thus, the technical relationship and the corresponding special technical feature result from a common (or equivalent) structure which is responsible for the common activity (or property). Part 1(f(iv)) indicates that when all alternatives of a Markush grouping can be differently classified, it shall not, taken alone, be considered justification for finding a lack of unity. Part 1(f(v)) indicates that when dealing with alternatives, it can be shown

that at least one Markush alternative is not novel over the prior art, the question of unity of invention shall be reconsidered, but does not imply that an objection shall be raised.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted. Again, this list is not exhaustive, as it would be impossible under the time constraints due to the sheer volume of subject matter instantly claimed. Therefore, applicant may choose to elect a single invention by identifying another specific embodiment not listed in the exemplary groups of the invention and examiner will endeavor to group the same.

The claims herein lack unity of invention under PCT rule 13.1 and 13.2 since the compounds defined in the claims lack a significant structural element qualifying as the special technical feature that defines a contribution over the prior art, see phosphoric compounds of Matsui et al. US 6,495,533. Accordingly, unity of invention is considered to be lacking and restriction of the invention in accordance with the rules of unit of invention is considered to be proper. Additionally, the vastness of the claimed subject matter, and the complications in understanding the claimed subject matter impose a burden on any examination of the claimed subject matter.

4. Applicants are advised that the reply to this requirement to be complete must include an election of invention to be examined even though the requirement be traversed (37 CFR 1.143).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the

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case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rei-tsang Shiao whose telephone number is (571) 272-0707. The examiner can normally be reached on 8:30 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/REI-TSANG SHIAO/

Rei-tsang Shiao, Ph.D.
Primary Examiner
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April 07, 2009